

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: L. HANS PFEILER	Confirmation No. 6384
Serial No	: 10/804,132	Group Art Unit: 1725
Filed	: March 19, 2004	Examiner: J. J. Johnson
For	: DEVICE AND METHOD FOR CONNECTING THE FACES OF PARTS	

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Sir:

This request is being filed concurrently with a Notice of Appeal and is responsive to the Final Official Action of December 22, 2006. Reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection is respectfully requested in view of the following remarks.

A prima facie case of anticipation has not been set forth and the Rejection Under 35 U.S.C. § 102(b) Is Improper.

Examiner's Assertion

In support of the 35 U.S.C. § 102(b) rejection over STEIGERWALD, the Examiner explains that STEIGERWALD teaches a method for joining parts having a profiled cross-section (claims 31, 33 and 53).

Applicant's Response

Applicant respectfully disagrees. Although it can be argued that the part 28 has a profiled cross-section, the other part 20 appears to be circular (see Fig. 1), and is not disclosed in STEIGERWALD as having a profiled cross-section. Indeed, the Examiner can point to no language which discloses that the

part 20 has a profiled cross-section. By way of non-limiting example, parts which have a profiled cross-section include, e.g., rails (see paragraph [0012] of the instant published application 2004/0256439).

Examiner's Assertion

In support of the 35 U.S.C. § 102(b) rejection over STEIGERWALD, the Examiner also explains that STEIGERWALD teaches a method for joining parts having, in addition to the profiled cross-section, a length which is greater than an overall width of the profiled cross-section (claims 31, 33 and 53).

Applicant's Response

Applicant respectfully disagrees. Although it can possibly be argued that the part 28 could have a length which is greater than an overall width of its cross-section, the other part 20 clearly has a length which is less than an overall width of its cross-section (see Fig. 1). Indeed, the Examiner can point to no language which discloses that either of the parts 28 and 20 have a length which is greater than an overall width of their cross-sections. By way of non-limiting example, parts which have a length which is greater than an overall width of the profiled cross-section include, e.g., rails (see paragraph [0012] of the instant published application 2004/0256439).

Nor can STEIGERWALD be read to teach this feature because STEIGERWALD is able to weld the parts by securing opposite ends of the parts to plates (e.g., plate 18). While such an arrangement can function to weld parts which are shorter in length and their overall cross-sectional width (as is shown in Fig. 1), it is not apparent that such a device could properly friction weld parts which have, among other things, a length which is greater than an overall width of the profiled cross-section.

Examiner's Assertion

The Examiner responded in the Interview that that he may properly interpret the overall diameter of the parts as their length.

Applicant's Response

Applicant respectfully disagrees. This interpretation is unreasonable at least because one having ordinary skill in the art would not interpret the length of the parts disclosed in STEIGERWALD to mean a diameter, and because it is apparent from Fig. 1 of STEIGERWALD that the length of the parts 20 and 28 would be measured parallel to or along their axial length.

Examiner's Assertion

In support of the 35 U.S.C. § 102(b) rejection over STEIGERWALD, the Examiner further explains that STEIGERWALD teaches clamping the parts in first and second clamping arrangements and that the first clamping arrangement surrounds a portion of one of the parts and the second clamping arrangement surrounds a portion of another of the parts (claim 53).

Applicant's Response

Applicant respectfully disagrees. Although it can possibly be argued that the part 28 is clamped (since STEIGERWALD teaches to hold part stationary), the other part 20 is clearly shown in Fig. 1 as having its back surface secured or fixed to the plate 18 with screws 22 and 24. As such, it cannot reasonably be argued that STEIGERWALD teaches clamping the parts in first and second clamping arrangements, much less, that the first clamping arrangement surrounds a portion of one of the parts and that the second clamping arrangement surrounds a portion of another of the parts. Indeed, the Examiner can point to no language which discloses that either of the parts 28 and 20 can be surrounded by any clamping arrangements. By way of non-limiting example, the figure of the instant application clear shown two clamping arrangements 2 and 2' which surround the parts 11 and 11'.

Examiner's Assertion

In the Interview, the Examiner explained that the screws 40 constitute part of a clamping arrangement that surrounds at least a portion of part 20.

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Applicant's Response

Applicant disagrees. This assertion ignores the meaning of the term “surrounding”, fails to consider that only part 20 (not part 28) is covered by any part of the screws 40, and is contrary to the disclosure of STEIGERWALD.

Applicant does not dispute that STEIGERWALD teaches to use screws 38/40 to secure the plate 18 to links 30/32. However, it is not understood how the screws 40 can be interpreted to encircle on all sides the part 20. As the Examiner may know, the term “surround” means to encircle on all sides simultaneously according to Webster’s II, *New College Dictionary*. Further, even if the Examiner were correct that the screws 38/40 encircle all sides of part 20 (which Applicant would dispute), the Examiner must acknowledge that the screws 38/40 in Fig. 1 clearly do not cover or encircle any portion of the other part 28. Nor can the Examiner properly argue that the screws 38/40 are structured and arranged to position ends of the parts against one another as recited in claim 53. Again, the screws 38/40 in STEIGERWALD merely connect the links 30/32 to the plate 18 (see col. 7, lines 2-9 of STEIGERWALD). Thus, the Examiner is improperly interpreting or ignoring the claim language and improperly ignoring what STEIGERWALD actually discloses in favor of an unsupported assertion of what the Examiner would like STEIGERWALD to disclose.

Examiner's Assertion

In the Advisory Action, the Examiner explains that he is merely giving the terms of the claims their broadest reasonable interpretation.

Applicant's Response

Applicant disagrees. As explained above, arguing that a circular part has a profiled cross-section is not reasonable. Nor is arguing that an overall diameter of the parts constitutes their length. Finally, the Examiner’s argument that the screws 40 constitute part of a clamping arrangement which surrounds at
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least a portion of part 20, is both unreasonable because it ignores the meaning of the term "surrounding" and fails to consider that only part 20 (not part 28) is covered by any part of the screws 40.

Finally, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP 2112, Applicants note that MPEP 2112 specifically states, in part:

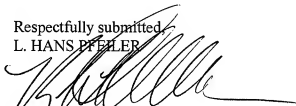
"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

CONCLUSION

Reconsideration of the Final Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
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